

200312102-1

RECEIVED
CENTRAL FAX CENTER
JUL 10 2007

10/789,963

REMARKS

This is a full and timely response to the final Official Action mailed May 10, 2007. Reconsideration of the application in light of the following remarks is respectfully requested.

Request for Continued Examination:

Applicant hereby requests Continued Examination for this application and entry and consideration of this amendment consequent thereto.

Claim Status:

Claims 26-45 and 59-70 were withdrawn from consideration under a previous Restriction Requirement and cancelled without prejudice or disclaimer. Claims 11-25, 46, 47 and 50 were also cancelled previously without prejudice or disclaimer.

To expedite the allowance of this application, withdrawn claims 1-10 are cancelled without prejudice or disclaimer by the present paper.

Claim 54 and claims 73-79, which were added by Applicant's amendment of February 26, 2007, have been withdrawn *improperly*. The Examiner has not made a Restriction Requirement as to claims 54 and 73-79 and has *not* explained or supported a reason for withdrawing claims 54 and 73-79 from consideration. Consequently, the final Office Action of May 10, 2007 is incomplete and should be withdrawn.

Thus, claims 48, 49, 51-58 and 71-79 are currently pending for further action. However, only claims 48, 49, 51-53, 55-58, 71 and 72 has received examination in the final Office Action.

200312102-1

10/789,963

Specification:

The final Office Action objected to the specification and requested that Applicant amend the specification to recite that the claimed latex exhibits self-adhesive properties at room temperature. This subject matter is supported in the application as originally-filed by, for example, original claim 48.

Accordingly, Applicant has amended the specification, as indicated above, to include this subject matter from original claim 48 in paragraphs 0004 and 0024. Therefore, following entry of this amendment, the objection to the specification may be reconsidered and withdrawn.

35 U.S.C. § 112, First Paragraph:

The recent Office Action rejected claims 48, 49, 51-53, 55-58, 71 and 72 under 35 U.S.C. § 112, first paragraph, as lacking a supporting written description in the specification. According to the Office Action, "the recited 'such that said latex layer remains in place on said first microporous layer without requiring a second [binder] and without being fused' in claim 48 does not have support in [the] originally filed specification." (Action of 5/10/07, p. 3). Applicant respectfully disagrees.

The indicated subject matter from claim 48 is very clearly supported in the original specification by, for example, paragraph 0015. Applicant's paragraph 0015 states that "a microporous substrate is coated with an optically clear or translucent layer of hard core/soft shell latex *configured to adhere to itself* with little or *no binder*. Once coated onto a microporous substrate, the layer of hard core/soft shell latex provides a porosity sufficient to allow the printing of an image onto the microporous substrate. Once printed, the layer of hard core/soft shell latex may be sealed by heat and/or pressure [i.e., fused] to form a single

200312102-1

10/789,963

continuous film." (Emphasis added). Thus, the latex layer can adhere to itself with "no binder" and prior to being fused, which occurs later after printing.

Thus, paragraph 0015 clearly provides a written description of the subject matter now recited in claim 48. Therefore, the rejection under § 112, first paragraph, should be reconsidered and promptly withdrawn.

Prior Art:

Claims 48, 49, 51-53, 55-589 and 71 were rejected as anticipated under 35 U.S.C. § 102(e) or, in the alternative, as unpatentable under 35 U.S.C. § 103(a) in view of U.S. Patent No. 7,086,732 to Kasperchik et al. ("Kasperchik"). For at least the following reasons, Applicant respectfully traverses these rejections.

Applicant deals first with the rejection under § 103, which is invalid under § 103(c). 35 U.S.C. § 103(c) states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Applicant notes that Kasperchik is available as prior art against the present application only under 35 U.S.C. § 102(e). The Office also recognizes this fact as Kasperchik was alternative applied by the outstanding Office Action under § 102(e). (Action of 5/10/07, p. 4). Applicant also notes that Kasperchik is assigned to the Hewlett-Packard Development Company, L.P. as indicated on the cover page of the Kasperchik patent.

Similarly, the present application is also assigned to the Hewlett-Packard Development Company, L.P. (See, recorded assignment at reel/frame 015115/0918).

200312102-1

10/789,963

Applicant hereby states that the subject matter of the present application and the Kasperchik reference were, at the time the invention of the present application was made, owned by, or subject to an obligation of assignment to, the same person, i.e., Hewlett-Packard Co. (See MPEP § 706.02(l)(2)).

Consequently, under 35 U.S.C. § 103(c), the Kasperchik reference *cannot* be applied as prior art against the present application under 35 U.S.C. § 103(a). Therefore, the alternative rejection which applies Kasperchik under § 103(a), must be reconsidered and withdrawn.

Thus, Kasperchik can only be applied against the present application in an anticipation rejection under § 102(e). Turning to the anticipation rejection, Applicant respectfully traverses the rejection under § 102 as follows.

Claim 48 recites:

A microporous coating comprising:
a first microporous layer comprising a first binder; and
a fusible latex layer deposited over said first microporous layer, wherein said fusible latex layer is microporous and includes particles comprising a hard core material and a soft shell material;
wherein said latex exhibits self-adhesive properties at a room temperature such that said latex layer remains in place on said first microporous layer without requiring a second binder and without being fused.

(Emphasis added).

In contrast, Kasperchik teaches: "The colorant-receiving layer 8 may also include a small amount of polymer binder to bind the core-shell polymer particles 10 into a layer." (Kasperchik, col. 6, lines 49-51). Thus, Kasperchik does not appear to anticipate the claimed subject matter in which "said latex exhibits self-adhesive properties at a room temperature such that said latex layer remains in place on said first microporous layer *without requiring a second binder and without being fused.*" (Emphasis added).

200312102-1

RECEIVED
CENTRAL FAX CENTER

10/789,983

JUL 10 2007


"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. For at least these reasons, the rejection based on Kasperchik should be reconsidered and withdrawn.

Conclusion:

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: July 10, 2007


Steven L. Nichols
Registration No. 40,326

Steven L. Nichols, Esq.
Managing Partner, Utah Office
Rader Fishman & Grauer PLLC
River Park Corporate Center One
10653 S. River Front Parkway, Suite 150
South Jordan, Utah 84095

(801) 572-8066
(801) 572-7666 (fax)

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted to the Patent and Trademark Office facsimile number 571-273-8300 on July 10, 2007. Number of Pages: 20


Rebecca R. Schow